

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TERI BENARON

Appeal No. 97-3982
Application 08/336,323¹

ON BRIEF

Before MEISTER, FRANKFORT and PATE, *Administrative Patent Judges*.

PATE, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 15. These are the only claims in the application.

¹ Application for patent filed November 8, 1994. According to appellant, this application is a continuation of Application 08/017,614, filed February 12, 1993 (abandoned).

Appeal No. 97-3982
Application 08/336,323

The claimed invention is directed to a massaging unit which contains a receptacle for a self-contained temperature storage enclosure that can provide heating or cooling as well as massage to a portion of the user's body.

Claim 1, reproduced below, is further illustrative of the claimed subject matter.

1. A hot and cold massaging unit comprising:

a flexible housing which has a generally flat shape that is conformable to a user's body and which includes at least one receptacle therein of similar flat shape;

vibrator means contained within said housing adjacent said receptacle; and

a self-contained temperature storage enclosure (1) which includes a material having the property of providing or releasing heat, (2) which has a flat shape similar to that of said receptacle so that said temperature storage enclosure can be easily inserted into an easily removed from said receptacle and (3) which is adapted both to transmit vibrations from said vibrator means and to apply its temperature to the user's body.

The references of record relied upon by the examiner as evidence of obviousness are:

Mensi	1,927,751	Sep. 19, 1933
Taylor	3,710,784	Jan. 16, 1973

Appeal No. 97-3982
Application 08/336,323

Westplate	4,592,358	June 3, 1986
Francis et al. (Francis)	5,097,822	Mar. 24, 1992
Ohnishi	Des. 290,654	June 30, 1987
Mack et al. (Mack)(U.K.)	2 090 746	July 21, 1982

THE REJECTION

The examiner has rejected claims 1, 2 and 5-7 under 35 U.S.C. § 103 as unpatentable over Taylor in view of Mack and Westplate.

The examiner has rejected claims 3, 4, 8 and 9 under 35 U.S.C. § 103 as unpatentable over Taylor in view of Mack, Westplate and further in view of Mensi.

The examiner has rejected claim 10 under 35 U.S.C. § 103 as unpatentable over Taylor in view of Mack, Westplate and Ohnishi.

The examiner has rejected claims 11-15 under 35 U.S.C. § 103 as unpatentable over Taylor in view of Mack, Westplate, Ohnishi and further in view of Francis.

Only the first group of claims, i.e., claims 1, 2 and 5-7, has been argued by appellant in the brief. Consequently, the examiner treats only these claims in detail in the answer.

According to the examiner, Taylor teaches a massaging unit with a flexible housing 40, a vibrator means 10, and a self-contained temperature storage enclosure 30 within the housing.

It is the examiner's view that Mack teaches that it is known to have a vibrator means having a flat bottom housing 5. Therefore, the examiner concludes that it would have been obvious to one having ordinary skill at the time the invention was made to remove the massage fingers 24 of Taylor, and following the teaching of Mack to provide a flat-bottom housing 5. Additionally, the examiner is of the view that Westplate teaches that it is known to provide a removable heating and cooling enclosure 21 and a receptacle as set forth in column 2, lines 46 to column 3, line 47. Therefore, the examiner has determined that it would have been obvious to provide a removable heating and cooling enclosure in the receptacle adjacent to the vibrator of Taylor.

OPINION

Appeal No. 97-3982
Application 08/336,323

We have carefully reviewed the rejections on appeal in light of the arguments of the appellant and the examiner. As a result of this review, we have determined that the applied prior art does not establish a case of *prima facie* case of obviousness with respect to the claims on appeal. Therefore, the rejections of these claims are not sustained. Our reasons follow.

It is our view that the combination of references cited by the examiner represents an exercise of impermissible hindsight on the part of the examiner in this consideration of claim 1 on appeal. We agree with the examiner that Taylor discloses a flexible housing, but we disagree that the vibrator plate is generally flat, inasmuch as Taylor depends upon finger ends 24 to simulate a fingertip massage. In our view, Mack adds little to the reference Taylor in that it actually teaches away from the claimed combination. Mack discloses a vibrator in a housing which is secured to the heating member by VELCRO strips so that it can be removed and placed exactly on the heating member where the massage is most necessary. In our view, the teaching of Mack when applied to the Taylor

Appeal No. 97-3982
Application 08/336,323

reference would have been to remove the massage motor from the housing of Taylor so that it could be placed any place along Taylor's massage heating pad. With respect to the Westplate reference, we are in agreement with the examiner that Westplate would have taught making the heating unit of Taylor of a removable nature for the self-evident advantage of being able to replace the cooling pack or heating pack when it is heated or cooled respectively. However, this teaching of Westplate in no way cures the deficiencies we have found in the combination of Taylor and Mack. For this reason, it is our conclusion that the examiner has used impermissible hindsight in combining the references to reject claim 1.

We have also reviewed the other prior art references applied by the examiner in rejecting the dependent claims on appeal. We find no evidence therein that would have supported a *prima facie* case of obviousness with respect to any of the appealed claims.

Appeal No. 97-3982
Application 08/336,323

SUMMARY

The rejection of claims 1 through 15 is reversed.

REVERSED

JAMES M. MEISTER)	
Administrative Patent Judge)	
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)	
CHARLES E. FRANKFORT)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
WILLIAM F. PATE, III)	
Administrative Patent Judge)	

Appeal No. 97-3982
Application 08/336,323

Appeal No. 97-3982
Application 08/336,323

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